

REMARKS/ARGUMENTS

Status of the Claims

Claims 2-8, 11-12, 14-19, 22, and 24-30 are currently pending in the application. Claims 2-4, 6, 8, 17, 22, 24-26, 28 have been amended. No new matter has been added by the amendments. No claims have been added or cancelled. Therefore, claims 2-8, 11-12, 14-19, 22, and 24-30 remain present for examination. Claims 24, 25, and 28 are independent claims.

Applicants respectfully request reconsideration of the rejection because either the Examiner has failed to show a *prima facie* case of anticipation or the amendments overcome the rejection. Indeed, "for anticipation under 35 U.S.C. 102, the reference must teach every aspect of the claimed invention." See MPEP §706.02, Original Eighth Edition, August, 2001, Latest Revision July 2008. 35 U.S.C. § 102(e) states:

A person shall be entitled to a patent unless — . . .

(e) the invention was described in — (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language; . . .

The publication of Farris (2002/0082962) cannot be considered prior art under 35 U.S.C. § 102(e) because Farris was not filed before the invention of the present application.

Farris has a filing date of July 27, 2001. Farris claims priority to a provisional application filed July 27, 2000. However, for the Examiner to use the earlier date of the provisional application, the Examiner must demonstrate that the material relied upon in Farris was present in the provisional application. See MPEP § 2136.03.

The present application (hereinafter the "Application") clearly claims benefit to the filing dates of three different applications. See *Application*, p. 1, lines 2-5. First, the

Application claims priority to PCT/US01/22,179 (hereinafter "'179 Application'") that was filed on July 11, 2001. The Application also claims priority to U.S. Patent Application No. 09/613,615 (hereinafter "'615 Application'") filed on July 11, 2000 and U.S. Patent Application No. 09/476,384 (hereinafter "'384 Application'") filed December 30, 1999. For purposes of examination, the earliest priority date of the Application is considered the date of invention. *See* MPEP § 2136.05.

As such, the Application has an invention date that is earlier than that of Farris. Indeed, the Application even has a priority date that antedates the priority date of Farris if the Examiner relies on the provisional application from which Farris claims priority. Therefore, Farris cannot be prior art under 35 U.S.C. § 102(e) because the filing date of Farris does not precede the priority date of the Application.

The benefit of the earlier priority date is set out below for Claim 24:

"A method for transferring a credit amount from a payor to a payee using a money order, the payor sending the credit amount to the payor through an online system comprising a payment enabler and a wide-area network, a payor computer and a payee computer are in communication with the wide-area network, the method comprising:" *See '384 Application*, Fig. 1A and 2, pp. 8-20; *'615 Application*, Fig. 1, p. 7; and, *'179 Application*, Description ¶¶ 4, 17, 20, and 38.

"the payment enabler receiving pay-out instructions, from the payor computer, the pay-out instructions include a payee, a residence address for the payee, and the credit amount, the credit amount having a first value;" *See '384 Application*, Fig. 1A and 2, pp. 18, 22, 42; and, *'615 Application*, Fig. 1, p. 7.

"the payment enabler receiving, from the payor computer, a first choice for a first handler, the first handler comprising one of a debit card handler, a bank handler, and a credit card handler;" *See '384 Application*, Fig. 1A and 2, pp. 18, 22-37; and, *'615 Application*, Fig. 1, p. 7.

“the first handler receiving the credit amount having the first value from the payor, the first handler receiving the credit amount having the first value as one of a group comprising of a debit card transfer, a bank funds transfer, or a credit card transfer;” See ‘384 Application, Fig. 1A and 2, pp. 18, 22, 42; and, ‘615 Application, Fig. 1 and 5, pp. 7, 17-19.

“the payment enabler receiving the credit amount having the first value from the first handler;” See ‘384 Application, Fig. 9, pp. 36-40; and, ‘615 Application, Fig. 1, and 5-8, pp. 17-22.

“the payment enabler converting the credit amount from the first value to a second value;” See ‘615 Application, p. 9; ‘179 Application, Description ¶ 31.

“the payment enabler receiving a second choice of a money order handler from the payee computer;” See ‘384 Application, Fig. 9, pp. 36-40; ‘615 Application, Fig. 1, and 5-8, pp. 17-22; and, ‘179 Application, Description ¶¶ 4, 17, 20, and 38.

“the payment enabler sending the pay-out instructions to the money order handler;” See ‘384 Application, Fig. 9, pp. 36-40; ‘615 Application, Fig. 1, and 5-8, pp. 17-22; and, ‘179 Application, Description ¶¶ 4, 17, 20, and 38.

“the money order handler receiving the credit amount having the second value from the payment enabler;” See ‘384 Application, Fig. 9, pp. 36-40; ‘615 Application, Fig. 1, and 5-8, pp. 17-22; and, ‘179 Application, Description ¶¶ 4, 17, 20, and 38.

“the money order handler creating a money order according to the pay-out instructions, the money order paid with the credit amount of the second value; and” See ‘384 Application, Fig. 9, pp. 36-40; ‘615 Application, Fig. 1, and 5-8, pp. 17-22; and, ‘179 Application, Description ¶¶ 4, 17, 20, and 38.

“the money order handler providing the money order to the payee, wherein the money order is provided to the payee by sending the money order to the payee’s residence address.” See ‘384 Application, Fig. 9, pp. 36-40; ‘615 Application, Fig. 1, and 5-8, pp. 17-22; and, ‘179 Application, Description ¶¶ 4, 17, 20, and 38.

Each independent claim contains similar claim elements. Thus, the claims must receive benefit of the earlier filing dates of these patents. The Examiner has cited broad swaths of the U.S. Provisional Application No. 60/221,042 (the “Farris ‘042 Application”) to show that Farris deserves the earlier filing date. But, Farris should not receive the earlier filing data for at least the following reasons:

Specific Teachings from References:

The Office Action does not note the specific components of the payment system within the provisional application. For example, the Final Office Action fails to demonstrate which component in the provisional application is the payment enabler, the handlers, the payee computer, and the payor computer. Indeed, the particular teaching or associations between the cited art and the claim terms could not be found by the Applicants.

In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.

37 C.F.R. § 1.104(c)(2)

Indeed, an Examiner must identify “each and every facet or the claimed invention is disclosed in the applied reference,” *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1462 (Bd. Pat. App. & Interf. 1990), to establish a *prima facie* case of anticipation. Each claim element in the cited reference must be identical to the element in the claim. *Glaverbel Société Anonyme v. Northlake Mktg. & Supply, Inc.*, 45 F.3d 1550, 1554 (Fed. Cir. 1995). Failure to mention even one claimed

element in a prior art reference is enough to “negate anticipation by that reference.” *Atlas Powder Co. v. E.I. DuPont De Nemours & Company*, 750 F.2d 1569, 1574 (Fed. Cir. 1984). Applicants cannot find a description of a payee computer or a payor computer.

The provisional application is also not an appropriate anticipatory reference because the provisional application does not show the claimed limitations as arranged. “[U]nless a reference discloses within the four corners of the document not only all of the limitations claimed *but also all of the limitations arranged or combined in the same way as recited in the claim*, it cannot be said to prove prior invention of the thing claimed and, thus, cannot anticipate under 35 U.S.C. § 102.” *Net Moneyin, Inc. v. Verisign, Inc.*, No. 2007-1565 (Fed. Cir. decided October 20, 2008), pp. 17-18. Further, the prior art reference must disclose the claimed invention “or direct those skilled in the art to the [invention] without any need for picking, choosing, and combining various disclosures not directly related to each other by the teachings of the cited reference.” *Id.*, p. 19 (citing *In re Arkley*, 455 F.2d 586, 587 (CCPA 1972)). Here, the Examiner has cited large sections of the provisional application describing different embodiments. The Examiner is required to point to the one embodiment describing all the claimed elements as arranged in the claim. Since the Examiner has failed to make such a finding, the rejection is improper. Therefore, the independent claims are allowable over the cited art for at least these reasons.

Enabling Disclosure:

Further, to be an anticipating reference, the cited art must have an enabling disclosure. See *Impax Laboratories, Inc. v. Aventis Pharmaceuticals, Inc.*, No. 2007-1513 (Fed. Cir. decided October 3, 2008), pp. 5-6. As explained, there is no mention of the interface between a payee computer and the payment enabler nor between the payor computer and the payment enabler. Farris only mentions kiosks and how the kiosk functions. Indeed, Farris states all functions of the system are incorporated into the kiosk. See U.S. Provisional Application No. 60/221,042 (the “Farris ‘042 Application”), pp. 25 and 28. Further, there are no working examples similar to the claimed embodiments. Working examples provide indication of an

enabling disclosure. *See Impax Laboratories*, No. 2007-1513 at p. 5. Without working examples, the provisional application does not provide an enabling disclosure.

Inherency:

The Examiner has stated that Farris describes the elements of the claims “inherently.” For example, the Examiner states: “Inherently, pay-out instructions regarding the payee, delivery location and credit amount are received because a designated recipient (i.e., payee) may receive the value (i.e., credit amount) at any location domestically or abroad including the device/location used by the payor (i.e., location).” *Office Action*, p. 8.

Applicants first wish to draw the Examiner’s attention to MPEP § 2112 where it states:

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). “To establish inherency, the extrinsic evidence ‘*must make clear that the missing descriptive matter is necessarily present*’ in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). (*Emphasis added*).

Further, MPEP § 2112 states that “‘In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.’ *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). . . .”

If Farris were to inherently describe the elements of the claims, it must be apparent that to transfer money between kiosks, a payor would have to enter the payee’s address or location. This is not apparent because the payor in Farris would enter the kiosk location for the payee and not the address of the payee. In Farris, the kiosk uses Terminal ID information to

determine the location of the kiosk the payee may use. *See Farris '042 Application*, p. 12. Payments are transferred in Farris to other kiosks at the kiosk location, not to the payee's location. *See Farris '042 Application*, pp. 24 and 27. Thus, there is no reason for a payor to provide the payee location because the kiosk location would suffice. As such, Farris cannot inherently anticipate the claims just because Farris describes using a stored value account.

For the above and other reasons, the claims are allowable over the cited art.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested. Applicants do not acquiesce to any argument not specifically addressed herein. Rather, Applicants believe the amendments and arguments contained herein overcome all rejections presented.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,



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